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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/629,323	07/31/2000	James F. Allsup	7554	4709

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EXAMINER
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KALINOWSKI, ALEXANDER G

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 12/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/629,323

Applicant(s)

ALLSUP, JAMES F.

Examiner

Alexander Kalinowski

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 06 March 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,5,8-13 and 15-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,8-13 and 15-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Claims 1, 2, 5, 8-13, and 15-20 are presented for examination. Of claims 1-16 originally filed on 7/31/2000, Applicant filed an amendment on 3/6/2003 canceling claims 3, 4, 6, 7, and 14 and amending claims 1, 5, 8, 10-12 and 15 and adding new claims 17-20. After careful consideration of Applicant's amendments and arguments the Examiner withdraws the grounds of rejection of claims 1-16 based on 35 USC 103. New grounds of rejection are established in the instant office action as set forth in detail below.

### ***Response to Arguments***

2. The Examiner acknowledges Applicant's response to the Request for Information as proper. Examiner notes that the Applicant filed an Information Disclosure Statement that includes references in response to the Request for Information.

3. Applicant argues that the rejection of claims 1, 3-7, 10 and 12-15 based on 35 USC 101 fall within the technological arts since Patents exist that are directed to the insurance industry or insurance products. The Examiner does not take issue with this statement. However, it appears that the Applicant has mistaken the meaning of the 35 USC 101 rejection. Claims 1, 3-7, 10 and 12-15 were rejected because the claims do not fall within the technological arts since the claims do not incorporate or recite some means of technology to carry out the claims such as the use of a computer or data processor. The invention as claimed can be carried out using manual steps. The Examiner withdraws the 35 USC 101 rejection 3, 4, 6, 7 and 14 due to Applicant's

Art Unit: 3626

cancellation of the claims. In addition the Examiner withdraws the 35 USC 101 rejection of claim 10 based on Applicant's amendment to the claim. However, the Examiner maintains the 35 USC 101 rejection of claims 1, 5, 12, 13, and 15 (see Paper No. 4). To overcome the 35 USC 101 rejection of the claims, the Examiner suggests incorporating the use of technology (i.e. a computer, data processor, etc.) within the limitations of the independent claims in question.

4. Applicant's arguments with respect to claims 1-16 have been considered and are persuasive. Although new grounds of rejection are established in the instant office action, the Examiner will address certain arguments directed to the SSCP reference.

As to the rejection of claims 1, and 12-14, Applicant argues that the SSCP reference does not disclose all the claim limitations. The Examiner disagrees. As an initial step, the Examiner will respond to the limitations that were present in previously pending claims 1 and 12-14. The Examiner refers the Applicant to the detailed grounds of rejection of the claims in the next section below with respect to newly added claim limitations. SSCP discloses a method of determining of the disabled qualifies to receive SSDI (i.e. interviewing claimants to determine eligibility)(page 2). SSCP also discloses filing a claim with the SSA (i.e. initiating and processing Social Security Disability applications ...)(page 2). SSCP further discloses obtaining an award from the SSA (i.e. coordination of overpayment recoveries resulting from an SSDIB award)(page 2). Therefore, Applicant's reference disclosed the claimed limitations of claim 1 and Applicant's arguments as to claim 1 are nonpersuasive. As to claim 12, Applicant argues that the reference does not disclose "obtaining the authorization from the

Art Unit: 3626

claimant and obtaining access to an approved deposit account". The Examiner stated that it was not clear from the SSCP reference how the overpayment recoveries service was implemented but that it would have been obvious to implement these steps for the motivations stated in the rejection. Furthermore, as to claim 13, the Applicant disagrees with Examiner's use of official notice. Applicant further argues that since claim 13 depends on claim 12 and since claim 12 is allowable, claim 13 is allowable based on its dependency to claim 12. Since the Examiner found Applicants arguments to claim 12 to be nonpersuasive, the Examiner finds Applicant's arguments to be nonpersuasive for the same reasons.

5. With respect to the declarations filed by Applicant, in light of the new grounds of rejection, the Examiner will defer any response to the declarations until the next formal communication.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 2, 8, 9, 11-13, and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable Social Security Disability Consultants (SSDC) (29 October 1993) in view of "Allsup Inc.'s Overpayment Recovery Service"(hereinafter Allsup) and Pollin, Pat. No. 5, 727,249 .

Art Unit: 3626

As per claims 1, 2, 8, 9, 11, 12, and 17-19, SSDC teaches a method of obtaining Social Security disability insurance benefits (SSDI) from the Social Security Administration (SSA) for a disabled individual, recovering overpaid benefits, and providing services after award comprising:

- a) determining if the disabled individual qualifies (SSDC; pg. 2, col. 3, line 9).
- b) filing a claim with the SSA for SSDI on behalf of the individual (SSDC; pg. 2, col. 2, line 11-12).
- c) obtaining an award of SSDI for the individual as a result of filing (SSDC; pg. 2, col. 1, lines 10-14).
- d) recovering disability benefits previously provided to the disabled person (SSDC; pg. 2, col. 2, lines 27-28).

SSDC does not explicitly disclose

recovering a predetermined amount of long-term disability benefits previously provided to the disabled person by a third party after award of SSDI by SSA and the disabled individual's receipt of SSDI payments.

However, Allsup discloses recovering a predetermined amount of long-term disability benefits previously provided to the disabled person by a third party after award of SSDI by SSA and the disabled individual's receipt of SSDI payments (i.e. we'll monitor your claim until retroactive benefits are awarded and ensure you understand your overpayment obligation ...). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include recovering a predetermined amount of long-term disability benefits previously provided to the disabled person by a third

Art Unit: 3626

party after award of SSDI by SSA and the disabled individual's receipt of SSDI payments as disclosed by Allsup within SSDC for the motivation of assisting the individual to settle the overpayment burden without the burdensome paperwork (see Allsup, page 1).

SSDC and Allsup do not explicitly disclose

obtaining from the disabled individual pre-authorization for direct recovery of the overpaid benefits from a deposit account.

However, Pollin discloses obtaining from the individual pre-authorization for direct recovery of obligations from a deposit account (i.e. generates a draft payable to payee and drawn on the payor's checking account pursuant to the payor's authorization)(col. 5, line 66 – col. 6, line 5). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include obtaining from the individual pre-authorization for direct recovery of obligations from a deposit account as disclosed by Pollin within the overpayment recovery methods of SSDC and Allsup for the motivation of collecting funds from a customer's checking account when authorized (col. 3, lines 44-47).

8. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over SSCD, Allsup and Pollin as applied to claim 12 above, and further in view of Examiner's use of official notice.

Art Unit: 3626

As per claim 13, SSDC, Allsup and Pollin teach the overpayment recovery as rejected in claim 12. However, SSDC does not expressly disclose the deducting of applicable fees from the overpayment. The Examiner takes official notice it was well known in the electronic service arts to deduct fees for services. For example, a coin counting machine takes in all the monies and provides a check for the total minus the counting fee, a credit card companies send the merchant the retail cost of the goods minus the service charge. Therefore, it would have been obvious to deduct the applicable fees from the recovery amount with the motivation of obtaining payment for services rendered and maintaining profitability.

9. Claim 5 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over SSCD, Allsup, and Pollin as applied to claims 1 and 12 above, and further in view of Examiner's use of Official Notice.

As per claims 5 and 15, SSCD, Allsup and Pollin do not explicitly disclose

Providing ancillary financial services after determining if the disabled qualifies to receive SSDI by extending funds to the claimant for use by the claimant before there is an award of SSDI for the disabled individual

However, the Examiner takes official notice that it was well known in the electronic service arts to extend loans to individuals based on projected awards to the individual. For example, companies specializing in income tax returns such as H&R Block routinely provide short term loans to customers based on the



Art Unit: 3626

projected Tax refund calculated by H&R Block when filling out tax returns. The loan is processed prior to the customer receiving the tax refund. The motivation would have been to provide a service to the customer while generating additional income to the service provider. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include Providing ancillary financial services after determining if the disabled qualifies to receive SSDI by extending funds to the claimant for use by the claimant before there is an award of SSDI for the disabled individual within SSDD, Allsup, and Pollin for the motivation stated above.

10. Claims 10 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Social Security Disability Consultants (SSDC) (29 October 1993), and in further view of Pritchard. (4,491,725).

As per claims 10 and 20, SSDC, Allsup and Pollin teach a post-disability products and services as disclosed for claim 1 above. However SSDC, Allsup and Pollin do not expressly teach computer software that gathers, integrates and utilized data from a plurality of unrelated federal forms to populate databases. Pritchard teaches software that gathers, integrates and utilized data from a plurality of unrelated forms to populate databases (Pritchard; col. 1, lines 59-66, col. 7, lines 40-46, and col. 3, lines 30-40). It would be obvious to none of ordinary skill in the art at the time of the

Art Unit: 3626

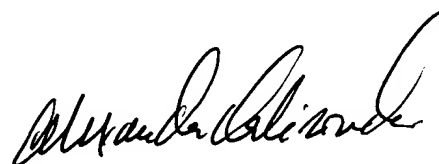
invention to add the computer software gathering and integrating feature of Pritchard with the Disability recovery method of SSDC, Allsup and Pollin with the motivation suggested by Pritchard of making information regarding services available (Pritchard; col. 1, line 51-53).

### ***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Kalinowski, whose telephone number is (703) 305-2398. The examiner can normally be reached on Monday to Thursday from 9:00 AM to 6:30 PM. In addition, the examiner can be reached on alternate Fridays.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached on (703) 305-9588. The fax telephone number for this group is (703) 305-7687 (for official communications including After Final communications labeled "Box AF").

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th Floor, receptionist.



Alexander Kalinowski

Primary Examiner

Art Unit 3626

11/30/03